

200207325-1

10/625,241

REMARKS

This is a full and timely response to the non-final Official Action mailed **December 20, 2007** (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous Restriction Requirement, claims 7-26 and 38-52 were withdrawn from consideration. To expedite the prosecution of this application, withdrawn claims 7-26 and 38-52 are cancelled by the present paper without prejudice or disclaimer. Applicant reserves the right to file continuation or divisional applications as permitted by 37 C.F.R. to the withdrawn claims or to any other subject matter described in the present application.

By the forgoing amendment, the specification and various claims have been amended. Additionally, new claims 53-58 have been added. Thus, claims 1-6, 27-37 and 53-58 are currently pending for further action.

Objection to Drawings:

The outstanding Office Action objected to the drawings as including a reference number, (202) in Fig. 4, that was not included in the specification. (Action, p. 2). Accordingly, Applicant has amended the specification above to properly include reference number (202) in the description of Fig. 4. No new matter has been added. Consequently, following entry of this amendment, the objection to the drawings should be reconsidered and withdrawn.

200207325-1

10/625,241

Prior Art:

Claims 1-6, 32-34, 36 and 37 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,332,062 to Phillips et al. ("Phillips"). For at least the following reasons, this rejection should now be reconsidered and withdrawn.

Claim 1 recites:

A method of providing web content to a printing device, said method comprising attaching a memory module storing said web content to a printing device consumable;

*wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.*

(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraphs 0014, 0020 and 0040. Specifically, Applicant's specification disclosed the following.

This specification describes a method and apparatus for uploading web content to a printer or printing device from a printing device consumable. This web content can then be used by a web server incorporated into the printer or printing device to serve up a web page that may be accessed and displayed with a web browser over the Internet or World Wide Web ("web"). The web page will provide information about the printing device. The described method includes storing web content on a memory module attached to a printing device consumable and uploading the web content or a web content interface to the printing device for storage in printing device memory when the consumable is loaded into the printing device.

(Applicant's specification, paragraph 0014).

In contrast, Phillips is directed to entirely different subject matter. Phillips does not appear to address a web page or a web server providing such a web page from a networked printing device. Consequently, Phillips does not teach or suggest the claimed method in which web content, defined as "content that is included in a web page that is served up by said printing device using an embedded web server," is stored in a memory module that is attached to a printing device consumable.

200207325-1

10/625,241

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. As demonstrated above, Phillips does not appear to teach or suggest the claimed method in which web content for a web page is provided to a printing device in a memory module attached to a consumable. Therefore, for at least the reasons explained here, the rejection based on Phillips of claim 1 and its dependent claims should be reconsidered and withdrawn.

Similarly, claim 32 recites:

A consumable for use with a printing device, said consumable comprising:  
a printing device consumable;  
a memory module attached to said printing device consumable; and  
web content stored on said memory module, *wherein said web content is included in a web page served up by said printing device using an embedded web server.*

(Emphasis added).

Support for the amendment to claim 32 can be found in Applicant's originally filed specification at, for example, paragraphs 0014, 0020 and 0040.

In contrast, as demonstrated above, Phillips is directed to entirely different subject matter. Phillips does not appear to teach or suggest a consumable for use with a printing device that includes "a memory module attached to said printing device consumable; and web content stored on said memory module, wherein said web content is included in a web page served up by said printing device using an embedded web server."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed.

200207325-1

10/625,241

Cir. 1987). See M.P.E.P. § 2131. As demonstrated above, Phillips does not appear to teach or suggest the claimed consumable with “a memory module attached to said printing device consumable; and web content stored on said memory module, wherein said web content is included in a web page served up by said printing device using an embedded web server.” Therefore, for at least the reasons explained here, the rejection based on Phillips of claim 32 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 4 recites “uploading a web content interface from said memory module to a memory of said printing device.” Phillips does not appear to teach or suggest this subject matter.

Claim 5 further recites “executing said web content interface with a controller of said printing device.” Again, Phillips does not appear to teach or suggest this subject matter.

Claim 6 recites “using said web content on said memory module through said web content interface.” Again, Phillips does not appear to teach or suggest this subject matter.

With respect to claims 4-6, Phillips does not appear to teach or suggest a web content interface that is uploaded from a memory module, executed by a printing device controller and used to interface web content remaining on a memory module of a consumable. Claim 37 recites similar subject matter.

In the Office Action, various portions of Phillips are cited in connection with claims 4-6 and 37, e.g., Phillips, col. 3, line 66 to col. 5, line 38. (Action, p. 4). However, the cited portions of Phillips do not appear to actually teach or suggest a web content interface as

200207325-1

10/625,241

defined in Applicant's specification and recited in claims 4-6. For at least these additional reasons, the rejection of claims 4-6 and 37 should be reconsidered and withdrawn.

Claims 27 and 28 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Philips and U.S. Patent No. 6,532,351 to Richards et al. ("Richards"). This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 1.

Additionally, claim 27 recites:

receiving data specifying desired web content from a purchaser of a printing device consumable; and  
storing said web content on said memory module attached to said printing device consumable.

The Office Action concedes that "Phillips does not disclose expressly receiving data specifying desired web content from a purchase of a printing device consumable." (Action, p. 5). Consequently, the Action argues that "Richards discloses receiving data specifying desired web content from a purchaser of a printing device consumable." (Action, p. 6). This, however, appears to be incorrect.

Applicant has reviewed the portions of Richards cited by the Office Action and finds no teaching or suggestion of the claimed "receiving data specifying desired web content from a purchaser of a printing device consumable; and storing said web content on said memory module attached to said printing device consumable."

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art,

200207325-1

10/625,241

as evidenced by Phillips and Richards clearly did not include the claimed "receiving data specifying desired web content from a purchaser of a printing device consumable; and storing said web content on said memory module attached to said printing device consumable." The subject matter of claim 28 likewise appears to be outside the scope and content of the cited prior art. Consequently, the cited prior art will not support a rejection of claims 27 and 28 under 35 U.S.C. § 103 and *Graham*.

Claims 29-31 were also rejected under 35 U.S.C. § 103(a) over the combined teachings of Phillips, Richards and U.S. Patent App. Pub. No. 2005/0240518 to Ishizuka. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claims 1 and 27.

Claim 35 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Phillips and Richards. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 32.

The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. Therefore, examination and allowance of the newly added claims is respectfully requested.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further

200207325-1

**RECEIVED  
CENTRAL FAX CENTER**

10/625,241

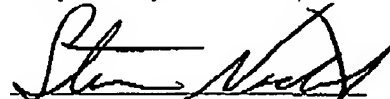
**MAR 20 2008**

arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,




Steven L. Nichols  
Registration No. 40,326

DATE: March 20, 2008

Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095  
(801) 572-8066  
(801) 572-7666 (fax)

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **March 20, 2008**. Number of Pages: **17**

  
Rebecca R. Schow